In paragraph 2 of the Office Action, claims 1-24 are rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over U.S. Patent Number 5,608,874 ("Ogawa et al."). This rejection is respectfully traversed.

The present invention deals with the problem of managing a large, electronic document collection, where the electronic documents include, for example, electronic letters, memos and e-mail messages, and where the electronic documents are organized and maintained in accordance with a hierarchy of electronic folders (e.g., see FIG. 3). In dealing with this problem, the present invention is capable of importing an electronic document, regardless of document format, extracting document attributes, storing and maintaining these extracted attributes in a separate data structure known as an STG file (e.g., see FIGS. 2A-2B and FIG. 3), and automatically categorizing and filing imported documents within the hierarchy of electronic folders based on an electronic analysis of the extracted attributes stored in the STG file associated with the imported document.

Accordingly, claim 1 defines a method for **managing a document collection** in a computer system. As amended, the method of claim 1 comprises, among other steps, the step of importing a document having a first format into a collection of documents in the computer system, where the collection of documents is organized within the computer system in accordance with a hierarchy of electronic folders. In addition, the method of claim 1 includes the step of extracting attribute data from the imported document and generating a data structure (e.g., an STG file) for the document, where the data structure contains the extracted attribute data in a second format, and wherein the data structure is stored and maintained in memory separate from the imported document. Finally, the method of claim 1 includes the step of linking the imported document to a first electronic folder if the extracted attribute data matches a set of predefined criteria corresponding to the first electronic folder.

In contrast, Ogawa et al. deals with the problem of **transferring large quantities of data**, such as billing information and/or account data, from any one of a number of "providers" to any number of different software applications which use the data. In doing

so, the format of the data is automatically identified, translated into an intermediate format, and eventually translated into a specific format so that the recipient (i.e., the application software) can receive and process the data as required.

The Applicants respectfully submit that Ogawa et al. has little, if any, relevance to **document** processing, and it has even less relevance to managing a large collection of electronic documents. As such, Ogawa et al. fails to render claim 1, as amended, unpatentable. More particularly, Ogawa fails to teach or suggest each and every step in the method of claim 1. For example, Ogawa et al. fails to teach or suggest **importing an electronic document into a collection of electronic documents**, which is organized in accordance with a hierarchy of electronic folders. Instead, Ogawa et al. involves "receiving . . . **data** from a wide variety of remote sources, identifying the format of the **data**, translating the **data** to a common format, sending the **data** to a recipient in an intermediate format, then translating the **data** to the specific format needed by the particular recipient [emphasis added]." Moreover, Ogawa et al., fails to teach or suggest the steps of generating a separately stored and maintained data structure containing attribute data extracted from an imported electronic document, and thereafter, **linking the imported document to a particular electronic folder if the attribute data contained in the data structure matches a set of predefined criteria corresponding to the electronic folder**. For at least these reasons, claim 1 is patentably distinguishable over Ogawa et al.

Nevertheless, the Office Action relies on column 1, lines 24-53 in Ogawa et al. to teach the step of importing a document having a first format into a computer system. However, the Applicants have amended this step so that it is now more clear that the document is being imported into a collection of electronic documents which are organized into a hierarchy of electronic folders. While column 1, lines 24-53, in Ogawa et al. discusses the need to frequently move or transfer electronic data, such as accounting data, from one computer system to another, and that conventional techniques and methods for doing so tend to involve some level of manual intervention, no where in this cited passage

does it discuss or allude to managing a collection of electronic documents or importing an electronic document therein.

In addition, the Office Action relies on column 15, lines 5-18, and column 16, lines 18-30, to teach the steps of extracting attribute data from the imported document and generating therefrom a data structure containing the extracted attribute data. Again, the Applicants have amended these steps to more clearly reflect the fact that the attribute data is being extracted from the imported document and, thereafter, used to generate a data structure which is separately stored and maintained in memory. However, column 15, lines 5-18, specifically deal with the function of "preprocessors", which are expressly defined as software programs that perform data format translations for specific data providers. More specifically, these programs translate provider data files into midformat files and record the number of transactions processed into a transaction table. The Applicants can find no reference in this passage to anything that might teach or otherwise suggest **extracting attribute data from an imported document** and then **using that attribute data to create a data structure** as defined by claim 1. Column 16, lines 18-30, specifically deal with the concept of "subscriber translation information", where subscriber translation information is apparently used by the preprocessors to translate provider data transaction information from a provider specific format to a midformat (i.e., an intermediate format). Although column 16, lines 18-30 does mention that attribute-value pairs may be used to describe certain fields found in the provider data file transaction, there is nothing that teaches or suggests **extracting attribute data from an imported document** and then **using that attribute data to create a data structure** as defined by claim 1.

It will be noted that the step of "linking the imported document to a first electronic folder if the attribute data contained in said data structure matches a set of predefined criteria corresponding to the first electronic folder" was incorporated into claim 1 from claim 29 (now canceled). In rejecting claim 29, the Office Action admits that Ogawa et al. fails to teach or suggest this method step. Accordingly, the Office Action turns to U.S. Patent Number 5,797,008 ("Burrows"). More specifically, the Office Action contends that

column 3, lines 48-58, in Burrows teaches the step of linking an imported document to a first electronic folder if the attribute data contained in the data structure matches a set of predefined criteria corresponding to the first electronic folder.

Burrows involves a data processing system that includes a memory having a data structure which, in turn, includes compressed index data structure entries and sampled index data structure entries. The index entries make up a single unified data structure that is used to index the records in an excessively large database, for example, Web pages in the World Wide Web. As was the case with Ogawa et al., Burrows really has nothing to do with managing a document collection in a computer system. Moreover, column 3, lines 48-58 of Burrows expressly describe the use of a Web browser to locate and retrieve, for example, Web pages. The cited portion also explains that a user can gain access to yet other Web pages by "clicking" on hyperlinks in previously retrieved Web pages. A hyperlink is a link in an HTML document that typically leads to another World Wide Web site. However, the Applicants respectfully contend that the cited passage, and hyperlinks in general, have nothing to do with linking an imported electronic document to one of many electronic folders in a hierarchy of electronic folders, if attribute data extracted from the electronic document, contained in the data structure associated with the imported document, matches a set of predefined criteria corresponding to the first electronic folder. Because Ogawa et al. fails to teach this method step, as admitted in the Office Action, and because Burrows also fails to teach this method step, as explained above, claim 1 is patentably distinguishable over the combined teaching of Ogawa et al. in view of Burrows.

Even if one could construe Burrows as teaching the step of linking the imported document to an electronic folder if attribute data contained in the corresponding data structure matches a set of predefined criteria associated with the electronic folder, the Applicants respectfully contend that one of ordinary skill in the art would not be motivated to modify the teachings of Ogawa et al. with the teachings of Burrows. The Applicants' reasoning is that Ogawa et al. and Burrows deal with two completely different issues. Ogawa et al., as stated above, involves the process of transferring and translating large

quantities of data, such as billing and/or accounting data, whereas Burrows deals with indexing records in large databases. As evidence, the Applicants point to the fact that the Field of Search associated with the Ogawa et al. patent contains not one common Class/Subclass as the Field of Search associated with the Burrows patent.

Despite the fact that Ogawa et al. and Burrows deal with two completely different subjects, the Office Action, with reference to canceled claim 29, states that "[i]t would have been obvious to a person of ordinary skill in the art of document linking at the time the invention was made to combine Ogawa's document importing with Burrows document linking because particular behavioral tasks are performed with the documents linked to an electronic folder and with user defined criteria." Section 2143 of the MPEP clearly sets forth the requirements needed to establish a *prima facie* case of obviousness. One of these requirements is that there must be some suggestion or motivation, in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Furthermore, the MPEP explains that the motivation for combining references cannot come from the Applicants disclosure. In the present case, the Applicants' respectfully contend that the motivation statement cannot possibly come from either Ogawa et al. or Burrows because neither patent deals with importing electronic documents, nor linking electronic documents to electronic folders which are associated with particular behavioral tasks. If the PTO believes that either Ogawa et al. or Burrows does somehow teach or suggest modifying the technique described in Ogawa et al. to specifically include the capability of linking an imported electronic document to a particular electronic folder if attribute data in the corresponding data structure matches predefined criteria associated with the electronic folder, then the Applicants respectfully request that the PTO provide a specific citation.

Since the PTO provides no citation in Ogawa et al. or Burrows to support the motivation statement, the PTO must be contending that the suggestion or motivation to modify the teachings of Ogawa et al. with the teachings of Burrows comes from the body of knowledge generally available to those of ordinary skill in the art. However, the

Applicants respectfully contend that the concept of linking an imported electronic document to a particular electronic folder, having associated therewith, certain behavioral characteristics is, not only lacking in the knowledge generally available to one of skill in the art, it is part of the Applicants claimed invention (e.g., see claims 39-46). If the PTO is, in fact, contending that importing electronic documents into particular electronic folders having associated therewith certain behavioral characteristics is knowledge generally available to those of ordinary skill in the art, the Applicants respectfully request that the PTO provide a prior reference. Otherwise, the Applicants contend the motivation statement is improper for relying on subject matter in the Applicants' disclosure.

For the reasons presented above, the Applicants respectfully contend combining the teachings of Ogawa et al. and Burrows based on the above-identified motivation statement is improper. Accordingly, the PTO has failed to establish its *prima facie* case of obviousness.

Claims 2-24 depend from independent claim 1. Therefore, these claims are patentably distinguishable over Ogawa et al., as well as Ogawa et al. in view of Burrows, for the reasons above. Thus, the Applicants respectfully request that the rejection of claims 1-24 under 35 U.S.C. §103(a) be withdrawn.

In paragraph 3 of the Office Action, claims 25-50 are rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Ogawa et al. in view of Burrows. As to claim 29, the rejection is moot since claim 29 was canceled. However, with respect to claims 25-28 and 30-50, the rejection is respectfully traversed.

Claims 25-28 and 30-50 variously depend from independent claim 1. However, independent claim 1, as amended, is patentably distinguishable over Ogawa et al. in view of Burrows, for at least those reasons presented above. Accordingly, claims 25-28 and 30-50 are patentably distinguishable over Ogawa et al. in view of Burrows for the same reasons.

It should be noted that despite their dependency on claim 1, several of claims 25-28 and 30-50 are patentably distinguishable over Ogawa et al. in view of Burrows for additional reasons. For example, dependent claim 30, as amended, further defines the

method of claim 1 as including steps for electronically analyzing the attribute data stored in the data structure, determining whether the imported document is to be automatically linked to the first electronic folder, based on the electronic analysis of the attribute data stored in the data structure, and identifying the document on an inclusion list if it is determined that the document is not automatically linked to the first electronic folder. Neither Ogawa et al. nor Burrows deal with linking imported electronic documents to particular electronic folders based on an electronic analysis of extracted attributes associated with the imported document, nor does Ogawa et al. or Burrows teach or otherwise suggest placing imported electronic documents on an inclusion list should they not be linked to the first electronic folder. The Office Action alleges, however, that these steps are taught by Burrows at column 8, lines 36-57, and column 6, lines 28-37. In fact, the cited portion of column 8 describes a "parsing module 30" capable of detecting and decoding certain attributes, whereas the cited portion of column 6 describes linking records in a large database using, for example, hyperlinks. Detecting and decoding attributes and the concept of hyperlinks are not equivalent to determining whether an imported, electronic document is to be automatically linked to a first electronic folder, based on an electronic analysis of the attribute data stored in the corresponding data structure. Nor are they equivalent to identifying the imported document on an inclusion list if it is determined that the document is not to be linked to the first electronic folder.

Dependent claim 31, as amended, further defines the method of claim 1 as including steps for electronically analyzing the attribute data stored in the data structure, determining whether the document is to be automatically excluded from being linked to the first electronic folder and identifying the document on an exclusion list if it is determined that the document is not to be automatically excluded from being linked to the first electronic folder. Here, the Office Action admits that neither Ogawa et al. nor Burrows teach the steps of determining whether the document is to be automatically excluded from being linked to a first electronic folder or identifying the document on an exclusion list if it is determined that the document is not to be automatically excluded from being linked to the

- 13 -

first electronic folder. However, the Office Action states that these steps would have been obvious to one of ordinary skill in the art "because the inclusion list identifies the documents that were excluded from the electronic folder during the categorization process." The Applicants respectfully contend that this reasoning merely points out an inherent feature of the claim itself. As stated above, the motivation statement needed to justify combining the prior references, cannot rely on the Applicants' disclosure. By merely stating an inherent feature of the claimed invention, the Applicants contend that the PTO is improperly relying on the Applicants' invention to support its obviousness argument. Moreover, the Office Action states that these steps would have been obvious to one of ordinary skill in the art because these steps allegedly "provide the user with the category criteria associated with that category." The Applicants respectfully contend that this is not necessarily a true statement, and even if it were a true statement, it is unclear why providing the user with category criteria would motivate one of ordinary skill in the art to modify Ogawa et al. by the inclusion of these method steps. For at least these reasons, the PTO has failed to establish a *prima facie* case of obviousness with respect to claim 31.

Dependent claim 32, as amended, further defines independent claim 1 as including the steps of monitoring document modifications and automatically linking the document to a second electronic folder if a document modification causes the attribute data to match a set of predefined criteria corresponding to the second electronic folder. The Office Action admits that neither Ogawa et al. nor Burrows teach the step of automatically linking the document to a second electronic folder if a document modification causes the attribute data to match a set of predefined criteria corresponding to the second electronic folder. However, the Office Action states that the step would have been obvious to one of ordinary skill in the art "because if a user modifies the contents of the document the modification can change the links and the document is modified to reflect the created links with the user's predefined criteria that correspond to the second electronic folder." First, the statement "if a user modifies the contents of the document the modification can change the

links" is nothing more than a rewording of the method step itself, and therefore cannot be used as motivation to support a *prima facie* case of obviousness. Second, the statement that "the document is modified to reflect the created links with the user's predefined criteria that correspond to the second electronic folder" is not accurate. One cannot modify a document to reflect a link that doesn't yet exist. Accordingly, the PTO has failed to establish a *prima facie* case of obviousness with respect to claim 32.

Dependent claim 33, as amended, further defines independent claim 1 as including the steps of monitoring document modifications and automatically deleting the link between the document and the first electronic folder if a document modification causes the attribute information to no longer match the set of predefined criteria corresponding to the first electronic folder. The Office Action admits that neither Ogawa et al. nor Burrows teach the step of automatically deleting the link between the document and the first electronic folder. However, the Office Action does state that the step would have been obvious to one of ordinary skill in the art "because if the user deletes an entire document all of the links associated with that document are deleted." The Applicants respectfully contend that the motivation statement is an irrelevant statement. Claim 33 has nothing to do with deleting an entire document. Because the Office Action does not provide valid motivation as to why the step of deleting the link between the document and the first electronic folder is obvious, the Applicants contend the PTO has failed to establish a *prima facie* case of obviousness with regard to claim 33.

Claim 39, as amended, further defines the method of claim 1 by reciting the step of automatically manipulating the document based on a predefined behavior associated with the first electronic folder. Again, the Office Action admits that neither Ogawa et al. nor Burrows teach this step. However, the Office Action states that the step would have been obvious to one of ordinary skill because a user can program a folder with particular behavioral characteristics. The Applicants respectfully contend that, once again, the Office Action is relying on an inherent feature of the claimed invention as motivation to support its obviousness argument. Accordingly, the motivation statement is invalid and the PTO has

- 15 -

failed to establish a *prima facie* case of obviousness to support its rejection of claim 39.

Dependent claim 43 also further defines the method of claim 1 by including the steps of linking the document to a folder, wherein the folder has associated with it a predefined behavior, and automatically manipulating the document in accordance with the predefined behavior. Again, the Office Action admits that neither Ogawa et al. nor Burrows teach these steps. However, the Office Action states that the steps would have been obvious to one of ordinary skill "because particular behavioral tasks are performed with the documents linked to an electronic folder and with user defined criteria and a user can program a folder with particular behavioral characteristics." Again, the Applicants respectfully contend that the motivation statement is invalid because it is not based on the teachings in the prior patents, nor is it based on knowledge generally available to those of ordinary skill. Rather, the motivation statement relies on an inherent feature of the claimed invention. Therefore, the PTO has failed to establish a *prima facie* case of obviousness for claim 43.

For the various reasons presented above, the Applicants respectfully request that the rejection of claims 25-28 and 30-50 under 35 U.S.C. §103(a) be withdrawn.

In paragraph 5 of the Office Action, claims 51-83 are rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Burrows. The rejection of claim 52 is considered moot because claim 52 has been canceled. However, with respect to claims 51 and 53-83, the rejection is traversed.

Independent claim 51, as amended, defines a program which executes a number of steps which parallel the method steps of amended claim 1. Accordingly, the reasons presented above regarding the patentability of claim 1 over Ogawa et al. in view of Burrows are also applicable with respect to claim 51, as well as claims 53-83 which depend therefrom. Thus, the Applicants respectfully request that the rejection of claims 51 and 53-83 under 35 U.S.C. §103(a) be withdrawn.

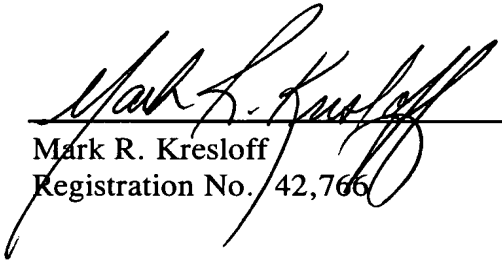The applicants believe the application is in condition for allowance. Notice of same

is earnestly solicited. If the Examiner has any questions regarding this application, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: _____

Mark R. Kresloff
Registration No. 42,766

Post Office Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: August 5, 1999

- 17 -